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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,521	09/20/2006	Werner Baschong	HU/1-23040/A/PCT	2780

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EXAMINER	
KARPINSKI, LUKE E	
ART UNIT	PAPER NUMBER
1616	

NOTIFICATION DATE	DELIVERY MODE
03/05/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/593,521	BASCHONG, WERNER	
	Examiner	Art Unit	
	LUKE E. KARPINSKI	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/21/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims

Claims 1-15 are pending and under consideration in this action.

Rejections/Objections

Claim Objections

Claims 1, 7, and 11 are objected to because of the following informalities:

Claim 1 appears to be missing the word 'or' in the lines designating the X, Y, and Z moieties.

Claim 1 should contain the phrase 'selected from' before the list of choices.

Claims 1, 7, and 11 make substantial incorrect use of commas and semicolons. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the phrase 'optionally substituted' as a selection for groups R3 and R4, 'optionally substituted cannot be a choice, only a modification of a choice.

Claim 1 further designates o as a number from 1-20, o should be changed to a symbol which will not be confused with other symbols and numbers.

Claim 4 recites, "R1 and R2 have the same meaning", and this is not common terminology in the art and may be misinterpreted. The examiner suggests the phrase 'R1 and R2 may be the same'.

Claim 2 is rejected for having a period in the fourth line of text after R and before 2.

Claim 11 is rejected for an unclear period. Submitted page 5 has what appears to be a period at the end of claim 11, however, there is also another dot resembling a period, and due to applicant's extraneous period in claim 2 the examiner requests that applicant confirm that claim 11 has a period.

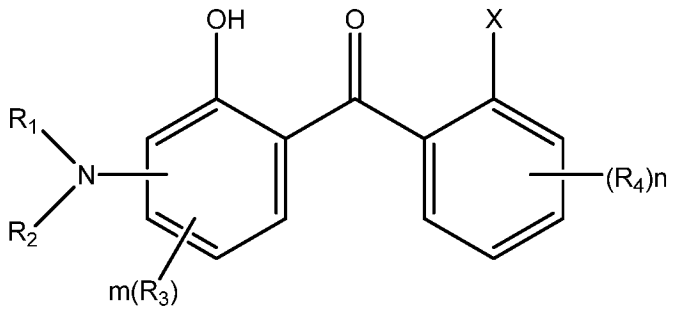
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,409,995 to Habeck et al.

Habeck et al. discloses the formula:



Wherein R1 and R2 are ethyl, R3 and R4 are hydrogen, X is a COOR5, wherein R5 is a 2-methylpropyl (isobutyl), and m and n are 0-3 (col. 4, lines 24-46 and col. 5, table 1 and Table 2 no. 2), and said compounds in UV filtering cosmetic preparation with additional UV filters, including cinnamic acid derivatives (octyl methoxycinnamate), antioxidants including tocopherol acetate (abstract and example 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,409,995 to Habeck et al.

Applicant Claims

Applicant claims a composition comprising a UV filter corresponding to the formula of claim 5

Determination of the Scope and Content of the Prior Art

(MPEP §2141.01)

The teachings of Habeck et al. are delineated above and incorporated herein.

Further Habeck et al. teach the same core structure as claimed, wherein R5 may be a C1-C12 alkyl and R1 and R2 are preferably an ethyl (col. 4, lines24-46) as pertaining to claim 5.

Ascertainment of the differences between the prior art and the claims

(MPEP 2141.01)

Habeck et al. do not explicitly disclose an example of the specific compound of claim 5. However, Habeck et al. do teach the same core structures and R groups to construct said compound and the use of such in compositions as a UV filter.

Finding of prima facie Obviousness Rational and Motivation

(MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select the same R groups as claimed because Habeck et al. suggests that the instant compounds can be used. In a prior art reference it is not necessary for all of the possible compounds to be exemplified in order for the art to render an invention obvious.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

2. Claims 10-12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,409,995 to Habeck et al. in view of USPN 6,024,942 to Tanner et al.

Applicant Claims

Applicant claims a composition comprising the formula denoted in claim 1.

Applicant further claims additional UV filters, an antioxidant, and a pigment regulator.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The disclosure of Habeck et al. is delineated above and incorporated herein.

Ascertainment of the Difference between Scope the Prior Art and the Claims (MPEP §2141.012)

Habeck et al. do not teach a pigment regulator or skin lightener as claimed in claims 10-12, 14, and 15. This deficiency in Habeck et al. is cured by Tanner et al. Tanner et al. teach sunscreen compositions comprising skin lightening agents including kojic acid (abstract, col. 16, line 55 to col. 17, line 4).

Finding of Prima Facie Obviousness Rational and Motivation

(MPEP §2142-2143)

Regarding claims 10-12, 14, and 15, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of Habeck et al. with kojic acid as taught by Tanner et al. in order to produce the invention of instant claims 10-12, 14, and 15.

One of ordinary skill in the art would have been motivated to do this because Habeck et al. and Tanner et al. both teach sunscreen formulations and Tanner et al. teach that it is known to add kojic acid so said formulations as a skin lightening agent. Therefore it would have been obvious to utilize the kojic acid of Tanner et al., in the formulations of Habeck et al. in order to produce a sunscreen formulation with skin lightening properties.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to

one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

Claims 1-15 are rejected.

No claims are allowed.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Friday 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/
Primary Examiner, Art Unit 1616